In re Appln. of Le Lann et al.
Application No. 10/544,289
Response to Office Action of March 13, 2009

REMARKS

The following remarks are responsive to the Non-Final Office Action of March 13, 2009.

Summary of the Office Action

At the time of the Office Action, claims 1–12 were pending. The claims were rejected as follows:

- Claims **1–3 and 8–10** stand rejected under **35 U.S.C. § 102(e)** as anticipated by **Multer** et al. (U.S. Patent No. 6,694,336) (hereinafter "Multer");

- Claims **4, 5, and 11** stand rejected under **35 U.S.C. § 103(a)** as being unpatentable over **Multer** in view of **Ims** et al. (U.S. Patent Application Publication No. 2002/0091533) (hereinafter "Ims").

- Claims **6, 7, and 12** stand rejected under **35 U.S.C. § 103(a)** as being unpatentable over **Multer** in view of Microsoft Computer Dictionary 5th Edition (hereinafter "**Microsoft**").

Applicants provide discussion below for distinguishing the claims of the present application from the art cited against it.

Power of Attorney

1. *Applicants' Power of Attorney does not appear to have been recognized.*

On September 3, 2008, Applicants filed a new Power of Attorney identifying the attorneys of Drinker Biddle & Reath LLP, Customer Number 08968 as representatives for this application.

The mailing information associated with this application has not been changed in any subsequent communications received from the U.S. Patent Office. Applicants respectfully request that the proper attorney information be associated with this application.

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Applicants' Prior Response Not Fully Considered

2. *Arguments presented in previous responses have not been considered in the present Office Action—Applicants request that the next Office Action not be made final.*

On p. 7 of the Office Action, the Examiner indicated that, "Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection." However, Applicants respectfully assert that the present Office Action contains no new grounds of rejection for the independent claims, and that, despite a slight rewording not touching on the substance of the rejection, the arguments are identical.

Applicants respectfully request that the Examiner indicate what constitutes the new grounds of rejection in the Office Action, and further request that the next Office Action not be made final, in the event that it is not an allowance.

35 U.S.C. §102(e) Anticipation of Claims 1–3 and 8–10 by Multer

3. *Multer does not disclose the claimed element, "at least two service portals, each hosting at least one personal information manager (PIM) service" in current claim 1.*

In the Office Action, on pp. 2–3, the Examiner only cites Figure 7 of Multer as disclosing the claimed element, "at least two service portals, each hosting at least one personal information manager (PIM) service".

However, neither Figure 7 nor any other passage of Multer discloses any service portal, or that a personal information manager (PIM) service is hosted in one of the devices connected by the network. Figure 7 only discloses a network connecting different elements such as a telephone, a home PC, a palm, a browser or an Office PC, but none of them is a mentioned as a service portal, and none of them is mentioned as hosting a personal information manager (PIM) service.

In the event the Examiner maintains this position, Applicants respectfully request that the Examiner indicate specifically how Multer is disclosing a service portal and how the devices shown in Figure 7 disclose the hosting of a personal information manager (PIM) service, with reference to specific elements in the figures or specific sections of the specification.

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    4. Multer does not disclose the claimed elements "(...) a synchronization client module, hosted in a first of said service portals" and "a synchronization server module, hosted within at least the second of said server portals" as required by claim 1.

    In his rejection of claim 1, the Examiner has simply cited Multer's "storage 300" against the first feature, and "synchronization receiver 60-910" against the second feature without any indication as to how Multer discloses such modules being hosted in service portals.

    As indicated in MPEP § 2131, and supporting case law, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the... claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

    It is not permissible to ignore the claimed arrangement of elements. As indicated in MPEP § 2131, the elements must be arranged as required by the claim... *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

    As recently stated by the Federal Circuit:

> Because the hallmark of anticipation is prior invention, the prior art reference-in order to anticipate under 35 U.S.C. § 102- must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim."

Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008).

    The Examiner has ignored the claim language. Multer does not teach or suggest the claimed hosting in any service portals, and therefore cannot be used to disclose these features. Again, Applicants request that the Examiner indicate, with specificity, how such devices can be construed as hosted in service portals, as required by the claim.

    5. Multer does not disclose the element "the first data synchronization means are adapted to establish a correspondence between the data stored in the portals" as required by claim 1.

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In the Office Action, on p. 2, the Examiner asserts that Multer discloses "first data synchronization means adapted to establish a correspondence between the data stored in the portals".

Applicants respectfully disagree with this characterization. The only disclosure given of this feature in Multer by the Examiner in the Office Action consists of the statement "difference means 602–608". The only occurrence concerning these difference means 602–608 in all of Multer is found in column 7, lines 45–67. This passage however does not disclose that the first data synchronization means are adapted to establish a correspondence between the data stored in the portals. Again, Applicants respectfully request that the Examiner indicate, with specificity, where teaching for _all_ of the claimed language can be found in the teaching of Multer.

6. *Multer does not disclose the feature "the first synchronization means includes a client-server architecture, the client of said architecture comprising a synchronization client module, hosted in a first of said service portals and communicating with a first server implementing the personal information manager service of said first service portal, and the server of said architecture comprising a synchronization server module, hosted within at least the other the second of said service portals and communicating with a second server hosting a different the personal information manager service of said second service portal, said modules communicating via a computer network."*

The Examiner rejected the above claimed elements on pp. 2–3 of the Office Action, indicating how these elements were taught by Multer.

Applicants respectfully disagree with the characterization of the teaching of Multer provided by the Examiner. First of all, the passages of Multer cited by the Examiner (col. 6, ln. 33–67; col. 7, ln. 45–67; "storage 300"; "transmitter 602-608"; "synchronization receiver 60-910" (?); "network 700") fail to disclose that the first synchronization means includes a client-server architecture. Against, for this feature in particular, the Examiner has merely stated "transmitter 602–608" as disclosing this claimed feature without provided any basis for asserting such. Applicants assert that such a statement by Multer does not disclose any kind of client-server architecture.

Moreover, with respect to this feature, claim 1 clearly indicates that:

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> the client of the client-server architecture comprises a synchronization client module hosted in a first of said service portals and communicating with a first server implementing the personal information manager service of said first portal; and
>
> the server of the client-server architecture comprises a synchronization server module hosted within at least the second of said service portals and communicating with a second server hosting the personal information manager service of said second service portal.

Again, the Examiner has simply cited "storage 300" against the first above-mentioned elements. However, there is no indication in the cited passages of Multer that the storage means 300 are communicating with a first server hosting personal information manager service of a first portal. Multer doest not disclose as well that the storage 300 is a synchronization client module.

Similarly, the Examiner has simply cited "synchronization receiver 60–910" against the second above-mentioned feature. Applicant asserts that these references are not in the cited passages or in the figures of Multer. Such a citation does not disclose that there is a communication with a second server hosting personal information manager service of a second service portal, different from the first one. Multer does not disclose as well that the so-called synchronization receiver would be a synchronization server module.

Again, the Examiner is respectfully requested to point out with particularity and specificity as to how each of these claimed elements can be found in the teaching of Multer.

7. *The Examiner improperly relies on different passages of Multer to derive that this document anticipates the subject-matter of claim 1.*

In rejecting claim 1, the Examiner relies on two different passages of Multer, respectively on col. 6, ln. 33–67 and col. 7, ln. 45–67. These two different passages relate to different embodiments (Figs. 3 and 4, respectively, Fig. 7), as indicated by their introduction ("Fig. 3 (resp. 7) shows yet another alternative embodiment").

The first passage (col. 6, lines 33–67) refers to two embodiments (Figs. 3 and 4) where a single storage server is shown, whereas in amended claim 1, first and second servers, each hosting different PIM services, are claimed. For this reason, this first passage

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cannot be considered as anticipating amended claim 1, where the number of servers is different.

The respective teachings of different passages of a same document cannot be used in combination to show that a claim is anticipated, when they refer to distinct embodiments, which is the case here.

Repeating from above, it is not permissible to ignore the claimed arrangement of elements. As indicated in MPEP § 2131, the elements must be arranged as required by the claim... *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

As recently stated by the Federal Circuit:

> Because the hallmark of anticipation is prior invention, the prior art reference-in order to anticipate under 35 U.S.C. § 102-must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim."

Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008).

Thus, Applicants respectfully assert that the Examiner has not demonstrated how Multer teaches the claimed arrangement of elements that are arranged as required by the claim.

For all of these reasons, Applicants assert that claim 1 is not anticipated by Multer. Since independent claims 8 and 10 contain similar limitations, Applicants assert that these claims, and dependent claims 2, 3, and 9 that depend therefrom, are not anticipated by Multer. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102 rejection from the present application.

35 U.S.C. §103(a) Obviousness of Claims 4–7 and 11–12 over Multer in view of Ims and Microsoft

8.   *Applicants rely upon the above arguments with respect to the remaining dependent claims, and assert that none of the additional references supplants the deficiencies identified above with respect to Multer.*

In the Office Action, on pp. 5–6, the Examiner combined Multer with Ims and Microsoft in establishing an obviating combination of references for various dependent claims in the

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present application. Without addressing the specifics of the additional references on the merits, Applicants rely upon the above arguments and assert that the disclosures of each of these additional references, alone or in combination, do not serve to solve the deficiencies of the Multer reference. The Examiner has cited these references for purposes related to the specifics of the dependent claims.

For these reasons, the Applicants assert that the claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the 35 U.S.C. § 103 rejections from the present application.

Conclusion

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims.

The Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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